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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,495	06/07/2000	Akihito Mochizuki	1232-4423US1	9609

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EXAMINER

BAROT, BHARAT

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/588,495	Applicant(s) MOCHIZUKI, AKIHITO	
	Examiner Bharat N. Barot	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/17/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Amended 8-12 and 15-22 remain for further examination.

The new grounds of rejection

2. Applicants' amendments and arguments with respect to claims 8-12 and 15-22 filed on August 19, 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 16 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16 and 20 recite a program code adapted to perform some steps. A program not claimed as embodied in computer readable media and execute in a computer or by a computer are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer (See MPEP section 2106, Seventh Edition, Revision No. 1 dated February 2000, at page 2100-10 and 2100-1 1).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 8-12 and 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Higley (U.S. Patent No. 5,790,793).

Higley's patent meets all the limitations for claims 8-12 and 15-22 recited in the claimed invention.

7. As to claim 8, Higley discloses a data communication apparatus (figures 3 and 5) comprising: a first transmission unit (502), arranged to transmit a URL representing the existence of additional information to a transmission destination (user) (figure 4; and column 5 lines 10-18); a reception unit (500), arranged to receive a reply from the transmission destination for the URL transmitted by the first transmission unit (figure 4; and column 5 lines 18-26); a generating unit (506, 510), arranged to generate a markup language file including the additional information to be accessed by the transmission destination (figure 4; and column 5 line 54 to column 6 line 8); and second transmission unit (504), arranged to transmit the markup language file including the additional information based on the reply received by the reception unit (figure 4; and column 5 line 27 to column 6 line 8)/(figure 5; and column 6 line 16 to column 7 line 37).

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8. As to claims 9-10, Higley discloses that the second transmission unit transmits the additional information in a manner different from that of the first transmission unit and to a terminal (browser) different from a terminal (email application) to which the data was transmitted by the first transmission unit (figure 5; and column 6 line 16 to column 7 line 37).

9. As to claim 11, Higley discloses a link to a location of the additional information is set in the URL transmitted by the first transmission unit (figures 4-5; column 5 lines 1-18; and column 6 line 64 to column 7 line 1).

10. As to claim 12, Higley discloses a processed content based on the reply received by the reception unit is further transmitted to the transmission destination (figures 3-5; column 5 line 27 to column 6 line 8; and column 6 lines 16-63).

11. As to claims 15-16, they are also rejected for the same reasons set forth to rejecting claim 8 above, since claim 15 is merely a method of operation and claim 16 is merely a computer readable medium for the apparatus defined in the apparatus claim 8.

12. As to claim 17, Higley teaches a data communication method comprising the steps of: recognizing a received email; displaying an image for display on the basis of a content recognized in the recognition step; and instructing a URL of the email recognized in the recognition step, to transmit a markup language file including image

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data in a method other than the email so as to process the image displayed in the display step (figures 4 and 6-9; column 5 line 1 to column 6 line 8; and column 7 line 38 to column 8 line 22).

13. As to claims 18-19, Higley teaches that in the instruction step it is instructed to print the image and store the image data (figures 5 and 10; column 6 lines 58-63; and column 8 lines 8-62).

14. As to claim 20, it is also rejected for the same reasons set forth to rejecting claim 17 above, since claim 20 is merely a computer readable medium for the method of operation defined in the method claim 17.

15. As to claims 21-22, Higley teaches an input unit arranged to input image data, wherein the additional information is the image data input by the input unit; and a storage unit stores the image data in a plurality of forms respective different image quality, wherein the second transmission unit transmits the image data each of the plurality of forms (figures 3, 5, and 6-9; column 4 lines 46-67; and column 6 line 16 to column 8 line 22).

Response to Arguments

16. Applicant's arguments have been fully considered. The examiner has attempted to answer (response) to the remarks (arguments) in the body of the Office action.

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17. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Additional References

18. The examiner as of general interest cites the following references.

- a. Graber et al, U.S. Patent No. 5,812,769.
- b. Levergood et al, U.S. Patent No. 5,708,780.

Contact Information

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.

Patent Examiner Bharat Barot

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October 24, 2005


BHARAT BAROT
PRIMARY EXAMINER